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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,847	03/12/2001	Gerd Mansfeld	Mo-6209/HR-183	1134

7590 11/10/2004

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EXAMINER

JOHNSON, EDWARD M

ART UNIT	PAPER NUMBER
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1754

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/762,847

Applicant(s)

MANSFELD ET AL.

Examiner

Edward M. Johnson

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25 and 26 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 9-11 and 13-24 is/are rejected.
- 7) ☒ Claim(s) 4 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 5-7, 9, and 13-24 rejected under 35 U.S.C. 102(b) as being anticipated by Yoshida et al. US 4,487,613.

Regarding claims 1 and 18-19, Yoshida '613 discloses a method for odorization of hydrocarbon gases comprising combination of 2-methoxy-3-isobutyl pyrazine and methyl acrylate (see columns 5 and 6, Formulas), neither of which contain sulfur, as a warning agent for hydrocarbon fuels (see abstract).

Regarding claims 9, 21-22, and 24 Yoshida '613 discloses a composition for odorization of hydrocarbon gases comprising combination of 2-methoxy-3-isobutyl pyrazine and methyl acrylate (see columns 5 and 6, Formulas).

Regarding claims 5 and 13, Yoshida discloses addition of 2-methyl-3-isobutyl pyrazine (see column 6, lines 56-61).

Regarding claims 6-7 and 14-15, 0.5 parts pyrazine to 100 parts methyl acrylate (see columns 5-6, Formulas).

Art Unit: 1754

Regarding claims 16-17, Yoshida '613 discloses low corrosivity (see column, line 17).

Regarding claims 20 and 23, Yoshida '613 discloses the compounds as a warning agent for hydrocarbon fuels (see abstract).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-3 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida '613.

Regarding claims 2-3 and 10-11, Yoshida fails to specifically disclose 2 different acrylic esters.

It is considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use ethyl acrylate in combination with the methyl acrylate of Yoshida because Yoshida discloses combinations of ethyl acrylate useful for odorization (see column 1, lines 14-16 and 64-68; column 2, lines 1-6).

Allowable Subject Matter

5. Claims 25-26 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter: It would not have been obvious to one of ordinary skill in the art at the time the invention was made to use the weight ratio of 9:1 to 1:9 of the two acrylic esters in an amount effective to warn of presence in the method of imparting odor to an odorless combustible gas of the instant claims 25-26.

7. Claims 4 and 12 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 25-26. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Response to Arguments

8. Applicant's arguments filed 3/26/04 have been fully considered but they are not persuasive.

It is argued that applicants respectfully note that 2-methoxy-3-isobutyl pyrazine... in gas odorants. This is not persuasive because Applicant appears to admit that the disclosed 2-methoxy-3-isobutyl pyrazine and methyl acrylate are "agents

Art Unit: 1754

for increasing the odor intensity". Applicant does not claim an odorant in its "own right" as distinguished from an agent that increases odor intensity and so the claim stands anticipated by the prior art disclosure. It is noted that the features upon which applicant relies (i.e. odorants "in their own right" as distinguished from "agents for increasing the odor intensity") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, and in any case, Yoshida discloses addition of mercaptan "and/or", 2-methyl-3-isobutyl pyrazine, which also anticipates the pyrazine by itself. Yoshida also discloses as much as 95% of this compound, wherein as little as 0.5% mixture containing mercaptan is used (see column 4, lines 27-31). Lastly, it is noted that the recitation "sulfur-free" occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward M. Johnson whose telephone number is 571-272-1352. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman


Art Unit: 1754

can be reached on 571-272-1358. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0987.

EMJ

November 5, 2004


STANLEY S. SILVERMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700